

REMARKS

The pending Office Action addresses and rejects claims 1, 2, 7-10, 13-20, 42, 43, and 46-50. This amendment is being filed concurrently with a Request for Continued Examination (RCE).

The undersigned attorney for Applicants thanks the Examiner for extending the courtesy of a telephone interview on December 1, 2006. During the interview, the Examiner suggested the amendments made herein to claims 1, 7-9, and 42, 43, and 46, indicating that the amended claims would distinguish over the Lai reference.

Amendments to the Claims

Applicants amend claims 1, 7-9, 42, 43, and 46 to recite that at least one of the first and second elongate members is an *implantable* spinal fixation rod. Support for this amendment can be found throughout the specification. No new matter is added.

Rejections Pursuant to 35 U.S.C. §102

(1) U.S. Patent No. 5,509,328 of Lai

The Examiner continues to reject claims 1, 2, 13-20, 42, 43, 46, 48, and 49 pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,509,328 of Lai. In Applicants' Amendment and Response filed on August 7, 2006, Applicants argued that Lai does not teach or even suggest a spinal fixation device having at least one "spinal fixation rod," as required by independent claims 1, 42, 43, and 46. In response, the Examiner argues that:

a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it anticipates the claim. In the instant case, that the structure of the device of Lai meets the claim limitations, as set forth above, and is rigid, is a sufficient indication that the device could be used to provide a support means for a spinal column if it were so desired.

Applicants disagree. At the outset, the term “spinal fixation rod” is not a recitation of intended use, but rather is a term that is well known to a person having ordinary skill in the art, and that certainly would not be understood to refer to any type of rod, such as a tube of a bicycle handlebar. Regardless, even if the term “spinal fixation rod” is considered to be a recitation of intended use, as noted by the Examiner the prior art must be capable of performing the intended use. As noted above, independent claims 1, 42, 43, and 46 are amended to recite an “implantable spinal fixation rod.” The bicycle handlebar of Lai is not capable of functioning as an implantable spinal fixation rod. The handlebars of Lai are not presently capable of being implanted and anchored to a spine.

Accordingly, claims 1, 42, 43, and 46, as well as claims 2, 13-20, and 48-49 which depend therefrom, distinguish over Lai.

(2) U.S. Patent No. 6,007,536 of Yue

Claims 1, 2, 7, 9, 13-16, 20, 42, and 43 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,007,536 of Yue. In Applicant’s previous response, Applicant argued that Yue does not teach a fastening member adapted to *lock* first and second elongate members in a fixed position relative to one another, as required by independent claims 1, 42, and 43. In response, the Examiner asserts that the worm gear adjustment portion (4) is the fastening element recited in claims 1 and 42. The worm gear adjustment portion (4) is merely a screw head that can be turned to manipulate the gear and adjust the angle between the plate and the blade (See Col. 3, lines 17-25). The worm gear adjustment portion (4) does not *lock* the plate and the blade relative to one another, as required by the claims. The gears are maintained in a locked position by mating the blade and the plate to bone.

Claims 1, 42, and 43 also recite that at least one of the first and second elongate members of the spinal fixation device is an *implantable spinal fixation rod*. Like Lai, Yue does not teach an implantable spinal fixation rod. Instead, Yue discloses an orthopedic plate for use in correcting problems with the long bones of the body, such as the shoulder, knee, ankle, and hip. Neither the blade nor the plate of Yue can be considered to be an implantable spinal fixation rod, and neither is capable of functioning as a spinal fixation device that is implanted in a patient’s spine.

Accordingly, claims 1, 42, and 43, as well as claims 2, 7-9, 13-26, and 20 which depend therefrom, distinguish over Yue and represent allowable subject matter.

Claim Rejections under 35 U.S.C. §103

Claims 8, 10, 47, and 50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yue.

As discussed above, independent claim 1 distinguishes over Yue. Thus, claims 8 and 10 are allowable at least because they depend from allowable claim 1.

Claims 47 and 50 depend from claim 46, which likewise distinguishes over Yue. Claim 46 requires a clamping mechanism formed on a terminal end of a first elongate element. Yue does not teach a first elongate element having a clamping mechanism formed on a terminal end thereof. Neither the blade (1) nor the plate (2) includes any type of clamping mechanism for receiving a terminal end of a second elongate element. The blade (1) and the plate (2) merely include gears formed on the terminal ends thereof. They do not include a mechanism by which one of the blade (1) and plate (2) receives and clamps on to the other. Accordingly, independent claim 46 distinguishes over Yue. Claims 47 and 50 are therefore allowable at least because they depend from allowable claim 46.

Conclusion

Applicants submit that all pending claims are now in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Respectfully submitted,

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